

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Franck Le

Title: IPV6 ADDRESS OWNERSHIP SOLUTION BASED ON
ZERO-KNOWLEDGE IDENTIFICATION PROTOCOLS OR
BASED ON ONE TIME PASSWORD

Appl. No.: 10/615829

Filing Date: 7/10/2003

Patent No. 7,546,456

Grant Date: 6/9/2009

Examiner: Yogesh Paliwal

Art Unit: 2435

Confirmation 8920
Number:

**RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent. The USPTO indicated in the letter mailed August 10, 2009 (copy attached as Exhibit A), that the decision on the Applicants' request was dismissed. As noted, the patent issued on June 9, 2009, as U.S. Patent No. 7,546,456.

The Patent Office determined that the patent was entitled to 580 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 894 days PTA, as shown on the attached sheet (Exhibit B), which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	1074 days
(b) Total Applicant delay:	180 days
Final PTA Determination:	894 days

Applicants therefore respectfully request that the patent be accorded 894 days PTA.

The patent is not subject to a terminal disclaimer.

Because this is a renewed request, Applicants do not believe that any fee is due, the fee having been paid with the Applicants' original request on January 30, 2009. However, if a fee is due, and should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date September 30, 2009

By



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EXHIBIT A

MAILED

AUG 10 2009

OFFICE OF PETITIONS

In re Patent No. 7,546,456 :
Le et al. :
Issue Date: June 9, 2009 : DECISION ON REQUEST FOR
Application No. 10/615,829. : RECONSIDERATION OF
Filed: July 10, 2003 : PATENT TERM ADJUSTMENT
Attorney Docket No. 088245-0111 : .

This is in response to the RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705, filed July 24, 2009, which is properly treated under 37 CFR 1.705(d).

Patentees request that the determination of patent term adjustment for the above-identified patent be corrected from five hundred eighty (580) days to eight hundred ninety-four (894) days.

Preliminarily, patentees request that the Office defer or delay a decision on this request for reconsideration until a final decision has been rendered in Wyeth v. Dudas, 580 F.Supp.2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008), which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120. However, the Office notes that there is no specific regulatory provision for requesting that a petition under 37 CFR 1.705(d) be held in abeyance.

The request for reconsideration of patent term adjustment is DISMISSED with respect to making any change in the patent term adjustment determination under 35 U.S.C. 154(b) of 580 days.

The above-identified application was filed on July 10, 2003. On August 20, 2007, a request for continued examination (RCE) was filed. On June 9, 2009, the above-identified application matured

into U.S. Patent No. 7,546,456 with a revised patent term adjustment of 580 days. The Office determined that the 406 days of Office delay, pursuant to 35 U.S.C. 154(b)(1)(B)¹ and 37 CFR 1.702(b),² overlap with the 760 days of Office delay,³ pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1),⁴ accorded prior to the filing of the request for continued examination. As such, the Office allowed entry of only the period of adjustment of 760 days. No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the 180 days of applicant delay, the patent issued with a revised patent term adjustment of 580 days.

On July 24, 2009, patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 37 CFR 1.705(d). Patentees

¹ Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b).

² As of the filing of the RCE on August 20, 2007, the application was pending three years and 406 days.

³ A nonfinal Office action was mailed on October 10, 2006, 14 months and 760 days after the application was filed on July 10, 2003.

⁴ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application[.]

aver that the correct number of days of Patent Term Adjustment is 894 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under 35 U.S.C. 154(b)(1)(A) overlaps with a delay under 35 U.S.C. 154(b)(1)(B) only if the delays "occur on the same day." Patentees contend that the periods of delay attributable to grounds specified under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) overlap by 92 days as they occur on the same calendar days in both periods. It appears that patentees contend that this overlapping period is the 92 days running from July 11, 2006 to October 10, 2006. Patentees maintain that the total non-overlapping PTO delay under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) is 1074 days as these periods do not occur on the same days. Given the 180 days of applicant delay, patentees assert entitlement to 894 days of patent term adjustment.

The Office has considered patentees' interpretation of the period of overlap, but finds it inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*⁵ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C.

⁵ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding § 1.702 overlap, the period of

adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date of filing of the application under 35 U.S.C. 111(a) on July 10, 2003, and ending on the date of filing of a request for continued examination on August 20, 2007 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). The relevant period ends with the filing of the RCE as the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) does not include the period subsequent to the filing of the RCE. 35 U.S.C. 154(b)(1)(B)(i).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 760 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the filing of the request for continued examination. There were no Office delays subsequent to the filing of the request for continued examination. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 406 days of patent term adjustment accrued for Office issuance of the patent more than three years after the filing date of the application.

All of the 406 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 760 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 406 days and the 760 days is neither permitted nor warranted. The Office accorded the greater period of 760 days for Office delay. Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 580 days.

The Office acknowledges the previous submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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Patent Term Adjustment Calculation System

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Docket Number: 088245-0111

Application Number: 10/615829

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	07/10/2003	0		
	14 month From Application date	09/10/2004	428		
	3 Year Period Starts	07/10/2006	1,096		
Edit Delete	Non-Final Office Action	10/10/2006	1,188	(760)	
	Non-Final Office Action + 3 months	01/10/2007	1,280		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/12/2007	1,313		33
Edit Delete	Final Office Action	05/18/2007	1,408		
	Final Office Action + 3 months	08/18/2007	1,500		
Edit Delete	Request For Continued Examination (including amendment)	08/20/2007	1,502	(406) 1074	2
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Edit Delete	Restriction Requirement Response Received at PTO	05/02/2008	1,758		
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Edit Delete	Final Office Action	08/01/2008	1,849		
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	Final Office Action + 3 months	11/01/2008	1,941		
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Patent Grant Date

06/09/2009

2,161

40 

Totals:

1,074

180

PTA:

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